# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/667,957 | 09/22/2003 | David Goldberg | D/97420C XERZ 2 001 15-1 | 1211 |

| 27885 | 7590 | 04/28/2005 |
|---|---|---|

FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP
1100 SUPERIOR AVENUE, SEVENTH FLOOR
CLEVELAND, OH 44114

| EXAMINER |
|---|
| WALLERSON, MARK E |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2626 | |

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/667,957 | GOLDBERG ET AL. |
| | Examiner | Art Unit | |
| | Mark E. Wallerson | 2626 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>*21 March 2005 and 22 February 2005*</u>.

2a)☒ This action is **FINAL**.  2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-5 and 14-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-5 and 14-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>*11/24/03*</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)  Office Action Summary  Part of Paper No./Mail Date 20050419

## Part III   DETAILED ACTION

### *Notice to Applicant(s)*

1.    This action is responsive to the following communications:  amendments filed on **2/22/2005 and 3/21/2005.**

2.    This application has been reconsidered.  Claims 1, 2, 3, 4, 5, 14, 15, 16, 17, and 18 are pending.

### *Claim Rejections - 35 USC § 112*

3.    The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.    Claims 1-5 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.  The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 1, there is no disclosure in the original specification for the limitation "storing a profile comprising a plurality of group subjects of unknown information **unrelated to a content of the print job**" as claimed in amended claim 1.  The areas of the original specification that were cited by Applicant that allegedly show support for this subject matter (pages 6 and 11) do not support the newly added subject matter.  Claims 2, 3, 4, 5, and 18 depend on claim 1 and are accordingly rejected for the same reason.

## PART 1

### *Claim Rejections - 35 USC § 103*

5.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.    Claims 1, 2, 3, 4, 5, 14, 15, 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cooper (U.S. 5,465,167) in view of Ferrel (U.S. 5,860,073).

With respect to **claims 1 and 18,** Cooper discloses means for automatic creation of a

form comprising a printer (84, figure 3); a print server for controlling system operations (which

reads on fax server) (column 1, lines 39-42); means for identifying a document white area of a

printing job and a user of the printer (which reads on identifying a segment of a field of a form in

which the user has marked, wherein the form may include a cover note field , and when the cover

note field is marked, the machine may include an image of the cover note field in an

automatically created cover sheet) (22, figure 1, column 1, lines 56-60, column 6, lines 26-28,

and column 7, lines 5-9); means for storing a profile comprising a plurality of group subjects of

unknown information *(the system of Figure 3 of Cooper permits the processor (66) to harvest or*

*collect information from varying data sources (72, 74, 76, and 78). This includes unknown*

*information, at least in the fact that it is unknown as to the source of the information (column 6,*

*lines 51-60))* desired by the user (which reads on an information database that includes a list of

distribution lists and a list of documents and forms, and the user can set up new distribution lists

and categories) (column 8, line 61 to column 9, line 9) to be pulled from a varying data stream

(72, 74, 76, and 78, figure 3); means for linking the server to the source of information (which

reads on the server giving database instructions) (column 8, lines 48-55 and column 1, lines 39-

42), and a printer (84) for printing the selected information in the document white space (column

7, lines 16-29).

Cooper differs from claims 1 and 18 in that he does not clearly disclose the group

segments include categorizable content comprising cartoons, puzzles, stock quotes, weather

forecasts, talk schedules, net news articles and newspaper stories, and extracting selective

segments of the categorizable content from the varying data stream.

Ferrel discloses a method for dynamically pouring varying content comprising different

titles from a network into a page (column 3, lines 8-28 and column 9, lines 28-52), wherein the

content includes information from various groups such as News, games, weather, business and

sports (figures 6 and 7 and column 6, lines 15-50), and extracting selective segments of the

categorizable content from the varying data stream (figure 6 and column 3, lines 45-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to have modified Cooper wherein the group segments include categorizable content

comprising cartoons, puzzles, stock quotes, weather forecasts, talk schedules, net news articles

and newspaper stories, and extracting selective segments of the categorizable content from the

varying data stream. It would have been obvious to one of ordinary skill in the art at the time of

the invention to have modified Cooper by the teaching of Ferrel in order to increase the

flexibility of the system as disclosed by Ferrel in column 9, lines 47-52).

With respect to **claim 2**, Cooper discloses memory means for storing a group of information from which desired information is stored (which reads on a database that includes categories of documents that the user may select from) (column 8, line 61 to column 9, line 9).

With regard to **claim 3**, Cooper discloses a harvester (calling means) to allow the server to collect information from the database (column 8, lines 48-45).

With respect to **claim 4,** Cooper discloses that the server is networked to plural users (column 8, line 67 to column 9, line 3).

With respect to **claim 5,** Cooper discloses an editor (column 6, lines 54-60).

With respect to **claim 14**, Cooper discloses a method of printing a selected content from a data stream (72, 74, 76, and 78) incidental to the printing of a selected document (form) or serendipitous communication of items of interest drawn from a data stream (the source of the data is unknown to the user at the time of input); generating the pre-selected document (which reads on the form) (10, figure 1) and storing a profile by subject of information desired by the user (which reads on an information database that includes a list of distribution lists and a list of documents and forms, and the user can set up new distribution lists and categories) (column 8, line 61 to column 9, line 9), and selecting means (a pointer) for selecting items of interest from the data stream (which reads on selecting files in which data defining the document are stored) (column 9, lines 5-9).

Cooper differs from claim 14 in that he does not clearly disclose selecting particular portions of the items of interest pertaining to a user in accordance with the profile of the user from a data stream, wherein the portions are dynamic and comprise cartoons, puzzles, stock quotes, weather forecasts, talk schedules, net news articles and newspaper stories.

Ferrel discloses selecting particular portions of the items of interest from a data stream (which reads on selecting world; national; health & fitness, or local subsets (412, figure 7) of the news data stream (410, figure 7), wherein the portions are generated by another (which reads on the information being provided by a publisher) (column 6, lines 64-67) and are dynamic (which reads on the information or content to be synthesized onto the page is updated continually) (column 9, lines 20-39), and serendipitous (the title(s) of the gathered information may remain constant, while the content pertaining to that/those title(s) change, therefore making the content serendipitous (column 9, lines 10-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cooper wherein particular portions of the items of interest from a data stream would be selected, and the portions are generated by another and are dynamic. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cooper by the teaching of Ferrel in order to give the user more personalized information to enjoy as disclosed by Ferrel in column 3, lines 25-27.

With respect to **claim 15**, Cooper discloses a printer (84) for recording the form, and means for deleting segments of data stored in the database (which reads on avoiding printed items of interest for avoiding repetition) (column 16, lines 40-46).

With respect to **claims 16 and 17**, Cooper differs from claims 16 and 17 in that he does not clearly disclose that the data stream is harvested from a website. Ferrel discloses a publishing system in which text or graphics are merged into a display region of a page (the abstract, lines 2-9), wherein browsers (which reads on a harvester) are used to tag text into the documents (column 2, lines 5-17). Additionally, Ferrel discloses gathering (harvesting) the

linked content onto the page (column 6, lines 64-66). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cooper wherein the browser would have been used to harvest data from a website. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cooper by the teachings of Ferrel in order to allow personalization of the page by allowing the user to insert various information such as stock quotations as taught by Ferrel in column 3, lines 25-27 and column 8, lines 12-21.

## PART 2

7.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.    Claims 1, 2, 3, 4, 5, 14, 15, 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (U.S. 5,513,254) in view of Ferrel.

With respect to **claims 1 and 18**, Markowitz discloses a print system (figure 1) for selective identification and communication of information on a document white space of a page for a print job (the abstract), comprising a printer (facsimile) (103 or 121) for generating a document comprising the cover page (or sheet of the facsimile transmission); a printer server (111) for controlling the printer operation, including means for identifying the document white

space (column 4, lines 46-57); means for storing a profile comprising subjects of unknown

information (the type of advertisement) (column 4, lines 21-35) unrelated to a content of the print

job (independent of the content of the facsimile information) (the abstract) and desired by the

user to be pulled from a varying data stream (from a network (107) and from sources external to

the network (column 3, lines 49-63); linking the server to the source of the unknown

information (figure 1); extracting selective segments of the content (ads) from the varying data

stream (column 4, lines 21-65 and column 6, lines 20-33), and printing on the cover page

information representative of the print (fax) job and the user and for randomly printing in the

document white space the selected ads (column 6, lines 20-65).

Markowitz differs from claims 1 and 18 in that he does not clearly disclose the group

segments include categorizable content comprising cartoons, puzzles, stock quotes, weather

forecasts, talk schedules, net news articles and newspaper stories, and extracting selective

segments of the categorizable content from the varying data stream.

Ferrel discloses a method for dynamically pouring varying content comprising different

titles from a network into a page (column 3, lines 8-28 and column 9, lines 28-52), wherein the

content includes information from various groups such as News, games, weather, business and

sports (figures 6 and 7 and column 6, lines 15-50), and extracting selective segments of the

categorizable content from the varying data stream (figure 6 and column 3, lines 45-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to have modified Markowitz wherein the group segments include categorizable content

comprising cartoons, puzzles, stock quotes, weather forecasts, talk schedules, net news articles

and newspaper stories, and extracting selective segments of the categorizable content from the

varying data stream. It would have been obvious to one of ordinary skill in the art at the time of

the invention to have modified Markowitz by the teaching of Ferrel in order to increase the

flexibility of the system as disclosed by Ferrel in column 9, lines 47-52).

With respect to **claim 2**, Markowitz discloses memory means for storing a group of

information from which desired information is stored (which reads on the databases) (115 and

117).

With regard to **claim 3**, Markowitz discloses a harvester to allow the server to collect

information from the database (column 4, lines 21-65).

With respect to **claim 4,** Markoitz discloses that the server is networked to plural users

(figure 1).

With respect to **claim 5,** Markowitz discloses an editor (which reads on the server)

(column 6, lines 20-65).

With regard to **clam 14**, Markowitz discloses a method of profile guided printing

(column 5, lines49-59) of a selected content from a data stream (column 6, lines 20-33)

incidental to a printing of a pre-selected document (the abstract) for serendipitous

communication of items of interest drawn (advertisements) drawn from the data stream (column

6, lines 20-35), in association with printing of the document (column 4, lines 21-65), comprising

generating a user profile (column 5, lines 49-54); generating the pre-selected document and

identifying the profile corresponding to the document (column 5, lines 49-59); randomly

selecting a particular user preference and corresponding portions thereto of the items of interest

from the data stream in accordance with the profile (column 5, lines 49-59 and ) wherein the

items of interest are non-vital to the printed document (the particular advertisements are

independent of the content of the user's facsimile information) (the abstract) and serendipitous

the user (the fax server selects the ads, therefore the user does not know what advertisements

would be presented to him) (column 4, lines 21-35), and the particular portions are generated by

another from the user (column 3, lines 49-63) and vary over time to comprise newsworthy items

to the user (column 6, lines 20-33) , associating the document and the items of interest  in a

combination document; and. printing the combination document (column 4, lines 37-65 and

column 6, lines 20-65).

Markowitz differs from claim 14 in that he does not clearly disclose selecting particular

portions of the items of interest pertaining to a user in accordance with the profile of the user

from a data stream, wherein the portions are dynamic and comprise cartoons, puzzles, stock

quotes, weather forecasts, talk schedules, net news articles and newspaper stories.

Ferrel discloses selecting particular portions of the items of interest from a data stream

(which reads on selecting world; national; health & fitness, or local subsets (412, figure 7) of the

news data stream (410, figure 7), wherein the portions are generated by another (which reads on

the information being provided by a publisher) (column 6, lines 64-67) and are dynamic (which

reads on the information or content to be synthesized onto the page is updated continually)

(column 9, lines 20-39), and serendipitous (the title(s) of the gathered information may remain

constant, while the content pertaining to that/those title(s) change, therefore making the content

serendipitous (column 9, lines 10-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to have modified Markowitz wherein particular portions of the items of interest from a

data stream would be selected, and the portions are generated by another and are dynamic.  It

would have been obvious to one of ordinary skill in the art at the time of the invention to have

modified Markowitz by the teaching of Ferrel in order to give the user more personalized

information to enjoy as disclosed by Ferrel in column 3, lines 25-27.

With regard to **claim 15**, Markowitz discloses selecting the advertisements at random

(which reads on avoiding repetition) (column 5, lines 16-23).

With respect to **claims 16 and 17**, Markowitz differs from claims 16 and 17 in that he

does not clearly disclose that the data stream is harvested from a website. Ferrel discloses a

publishing system in which text or graphics are merged into a display region of a page (the

abstract, lines 2-9), wherein browsers (which reads on a harvester) are used to tag text into the

documents (column 2, lines 5-17). Additionally, Ferrel discloses gathering (harvesting) the

linked content onto the page (column 6, lines 64-66). Therefore it would have been obvious to

one of ordinary skill in the art at the time of the invention to have modified Markowitz wherein

the browser would have been used to harvest data from a website. It would have been obvious to

one of ordinary skill in the art at the time of the invention to have modified Markowitz by the

teachings of Ferrel in order to allow personalization of the page by allowing the user to insert

various information such as stock quotations as taught by Ferrel in column 3, lines 25-27 and

column 8, lines 12-21.

### Response to Arguments

9.      Applicant's arguments with respect to claims 1, 2, 3, 4, 5, 114, 15, 16, 17, and 18 have

been considered but are moot in view of the new ground(s) of rejection.

## *Conclusion*

10.　Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

　　　A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this
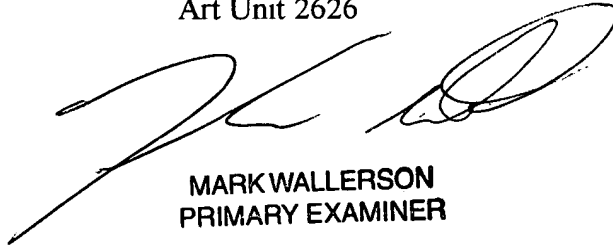
final action.

　　　Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470.

The examiner can normally be reached on Monday-Friday - 6:30-4:00.

　　　If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626

MARK WALLERSON
PRIMARY EXAMINER